RESPONSE AND REMARKS

The Office Action was organized by numbered topics. Responsive remarks herein refer to the Office Action Topic Numbers, or provide a citation in the format: "*Office Action*, Topic No. #, p. #."

ELECTION/RESTRICTIONS

In the Office Action, newly amended Claim 28 was withdrawn from consideration on the grounds that the new amendments were directed to features identified by a previous restriction requirement as set apart from the elected Claims. *Office Action*, Topic No. 2, pgs. 2-3.

Applicant(s) respectfully withdraws Claim 28 without prejudice to later requesting reinstatement of the Claim or later filing a continuation and/or divisional application.

SECTION 102(e) REJECTIONS

In the Office Action (Topic Nos. 4-5), Claims 12 and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kara et al. (PCT Publication No. WO 99/21330, "*Kara II*").

In the Office Action (Topic Nos. 6-9), Claims 27 and 50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kara et al., (U.S. Patent No. 6,233,568; "*Kara*").

In the Office Action (Topic Nos. 10-12), Claims 44 and 45 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nicholls (U.S. Patent No. 5,485,369, "*Nicholls*").

SECTION 103(a) REJECTIONS

In the Office Action (Topic Nos. 15-17), Claims 29, 31 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nicholls* in view of *Kara*.

In the Office Action (Topic Nos. 18), Claims 29, 31 and 49 (and in the text of the rejection, also, Claims 33, 34, 35, 36 and 42) were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nicholls* in view of *Kara* and Thiel (U.S.

Patent No. 5,699,258, "*Theil*"); although not mentioned in the general rejection, a reference identified only as "Fisher" was also mentioned in the text of the rejection explanation.

RESPONSIVE REMARKS REGARDING SECTION 102 AND 103 REJECTIONS

Claims 12 and 30

In rejecting Claims 12 and 30, the Office Action posits that *Kara II* discloses, among other things, "[[c]]ollecting from a user, parcel specifications ... shipping preferences for a particular parcel ..., the parcel specification includes an origin address (Kara discloses the use of delivery address, return addresses, which the examiner considers to be an origin address, ... and a parcel type, ..." *Office Action*, Topic No. 5.a, p. 3.

In rejecting Claims 12 and 30, the Office Action further posits that *Kara II* discloses, among other things:

> Collecting, from a second user, destination address which includes a zip code (Kara discloses providing a delivery service with information as to how the documents should be delivered, and delivery preferences, which includes service as well as address (Page 14, lines 13-28, the recipient discloses whether the mail is sent via physical mail, or electronic mail, therefore different carriers, and that information would include which carrier would deliver the mail (see abstract)....

Office Action, Topic No. 5.b, pgs. 3-4.

The Office Action further asserts that "[w]here the information is being obtained, whether it is from a first user, third user or second user, it is still collecting the information from an outside source, the processing the information the same way. Therefore the limitation of collecting a request from a 'second user' is not considered to be a functional limitation, due to the fact that the software would run the same regardless of if the request was coming from a first user or a second user." *Office Action*, Topic No. 33, p. 15.

The rejection of Claims 12 and 30 under Section 102(e) as being anticipated by *Kara II* have been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and

respectfully request reconsideration and allowance of Claims 12 and 30.

For the reasons given below, it is respectfully asserted that the above-characterizations of *Kara II* fail to fully reflect all of the limitations of the rejected Claims regarding collecting input from users. Even so, Claim 12 has been amended to more distinctly claim the claimed invention.

It is respectfully asserted that the Office Action's above-quoted characterization of *Kara II* merely shows input by a first user and input by a second user. As distinguished from the Office Action's above-quoted characterization of *Kara II*, amended Claim 12, for example, recites:

> ... collecting from a second user, a request that a first user ship a particular parcel from the first user to the second user ...

That is, as claimed by Claim 12, the second user, who will be the recipient of the parcel to be shipped, requests that the first user ship a parcel.

It is respectfully asserted that *Kara II* fails to disclose the above-recited limitations of Claim 12. In considering the differences between the claimed invention and *Kara II*, it is respectfully submitted that the abstract of *Kara II* is instructive. According to *Kara II*:

> A system and method for transmission of a document from a sending location to a receiving location by way of a trusted way location is disclosed. A selected document is physically or electronically transmitted by a sending location to a letter server operated by a delivery service. A confirmation of transmission of the document is provided to the sender by the delivery service. Thereafter, the letter server reproduces the document in original quality, accompanied by any necessary items such as a delivery container and/or delivery instructions. The delivery service then delivers the reproduced document such as through electronic delivery or inducting the reproduced document into its delivery paradigm for physical delivery to the indicated recipient.

Kara II, Abstract.

According to the above-quoted Abstract of *Kara II*, a sender (e.g., a first user) sends/transmits a document to a second location (a letter server operated by a delivery service). The delivery service then delivers the document to the indicated recipient. *Kara II*, Abstract.

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Even assuming for the sake of argument that the delivery service could be characterized as a "second user" as recited by, for example, Claim 12, it is respectfully asserted that there is no evidence that *Kara II* discloses, or even contemplates, as recited by Claim 12, "... a request [from a second user] that a first user ship a particular parcel from the first user to the second user ...." That is, it is respectfully submitted that there is no disclosure in *Kara II* that the delivery service requests that the sender (the first user) ship a parcel from the first user to the second user (the delivery service).

On the other hand, if the recipient of *Kara II* is to be considered the second user, then it is further respectfully asserted that there is no evidence that *Kara II* discloses, or even contemplates, as recited by Claim 12, "... a request [from a second user] that a first user ship a particular parcel from the first user to the second user ...." That is, it is respectfully submitted that there is no disclosure in *Kara II* that the recipient requests that the sender (the first user) ship a parcel from the first user (the shipper) to the second user (the recipient).

Further, for the reasons given below, it is respectfully asserted that contrary to the Examiner's above-quoted characterizations of *Kara II* regarding the asserted disclosure by *Kara II* (see, e.g., *Office Action*, Topic No. 5.b, pgs. 3-4), *Kara II* discloses that the first user (the sender) provides both origin address and delivery (destination) address.

Applicant respectfully disagrees with the assertion in the Office Action that "the limitation of collecting a request from a 'second user' is not considered to be a functional limitation, due to the fact that the software would run the same regardless of if the request was coming from a first user or a second user." (*Office Action*, Topic No. 33, p. 15.)

First, it is respectfully submitted that the Office Action fails to cite any evidence to support the above-quoted assertion that "... the software would run the same regardless of if the request was coming from a first user or a second user." (*Office Action*, Topic No. 33, p. 15). Moreover, it is respectfully asserted that the above-quoted assertion fails to give full consideration to all of the limitations of, for example, Claim 12, which recites:

according to the request by the second user, collecting, from the first user via a first computer device, a set of information comprising: (A) parcel specifications for shipping the particular parcel to the second user, (B) an origin address associated with the particular parcel, and (C) shipping preferences for shipping the particular parcel to the second user;
collecting, from the second user via a second computer device, a set of recipient information comprising: (A) a destination address for the second user to which the particular parcel is to be shipped from the first user, (B) an identification of a carrier to be used in shipping the package to the second user, and (C) a delivery service by which the carrier is to ship the package to the second user;

In particular, the above-quoted assertion in the Office Action fails to consider the difference in processing due to the limitation that the claimed system "... collect[s] [information], from the first user via a first computer device ..." and then "... collect[s] [recipient information], from the second user via a second computer device ..." It is respectfully asserted that the above-quoted assertion from the Office Action is grounded on an unsupported assumption that the claim is directed only to the most centralized portion of a computer system; the claims are not so limited.

Rather, as compared to the above-quoted assertion in the Office Action, it is respectfully asserted that the claimed limitations of "...collecting, from the first user via a first computer device, a set of information comprising: (A) parcel specifications for shipping the particular parcel to the second user, (B) an origin address associated with the particular parcel, and (C) shipping preferences for shipping the particular parcel to the second user; ..." and then "... collecting, from the second user via a second computer device, a set of recipient information ..." are functional limitations that require different processing than if all of the information were collected from a single source.

Further, it is respectfully asserted that the rule that prescribes giving claims the broadest interpretation (See, e.g., MPEP §2106) does not allow an interpretation to flip-flop definitions of the interpreted elements. That is, in the present case of Claim 12, for example, the claimed "a first user" should not, for one claimed term of Claim 12, be interpreted as the sender; then for another claimed term of Claim 12, be interpreted as the recipient; and/or then, for another

claimed term of Claim 12, be interpreted as the delivery service. Accordingly, because the plain language of Claim 12 claims that the first user ships, (a first user ship a particular parcel from the first user to the second user), then it is respectfully asserted that the claimed "first user" in Claim 12 must consistently be interpreted as a shipping or sending user. Further, because the plain language of Claim 12 claims that the first user ships a parcel from the first user to the second user, the second user must consistently be interpreted as a recipient, or receiving user.

As compared to the recitation by Claim 12 of "... collecting, from the second user ... a destination address for the second user to which the particular parcel is to be shipped from the first user ...", *Kara II* discloses that the first user (the sender), not a second (recipient) user, provides both origin address <u>and</u> delivery address. Specifically, *Kara II* discloses that,

> "...[p]referably, the sender indicates a preference for delivery of the document, such as through inclusion of delivery address information. Where this information is a physical address it might be presumed that delivery is to be physical, by way of postal delivery. Likewise, where the address information indicates an electronic address, such as a telephone number or e-mail address, delivery might be presumed to be commensurate with such addressing schemes."

Kara II, p. 14, lines 3-9.

The Office Action cites p. 14, lines 13-28 of *Kara II* as supporting the proposition that *Kara II* "...discloses providing a delivery service with information as to how the documents should be delivered, and delivery preferences, which includes service as well as address ...." *Office Action*, Topic No. 5.b, pgs. 3-4. However, as compared to the above-quoted assertion by the Office Action, it is respectfully submitted that the cited portion of *Kara II* does not disclose a recipient as providing any address. Specifically, the cited portion of *Kara II* states:

> Of course, a recipient of such documents may indicate a preferred method of delivery. For example, recipients may provide the delivery service with information, as to how documents should be delivered, that is stored by the delivery service for subsequent reference when a document is to be transmitted. Such delivery preference information may include strata of

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> delivery choices, such as identify of senders or types of documents for which a particular delivery method is to be used. Accordingly, a recipient may prevent the electronic delivery of unsolicited or unwanted documents through such systems as e-mail and relegate such documents to delivery by more conventional means. Moreover, a recipient might even designate certain types of documents and/or particular senders for which document delivery may be forgone, if desired.

Kara II, p. 14, lines 12-23.

In view of the above-quoted explanation by *Kara II*, it is respectfully asserted that, contrary to the assertion by the Office Action that *Kara II* "...discloses providing a delivery service with information as to how the documents should be delivered, and delivery preferences, which includes service *as well as address* ..." (*Office Action*, Topic No. 5.b, pgs. 3-4 (emphasis added)), *Kara II* does not disclose a recipient (a first user) providing "... a destination address for the second user to which the particular parcel is to be shipped from the first user ..." as claimed by Claim 12. More specifically, the above-quoted portion of *Kara II* cited in the *Office Action* (*Office Action*, Topic No. 5.b, pgs. 3-4 citing *Kara II*, p. 14, lines 13-28), contains no disclosure that the recipient ever provides the recipient's *address*. Yet further, it is respectfully asserted that there is no evidence that a *Kara II* recipient would provide the recipient's address because, according to *Kara II*, the recipient's address has already been provided by the *Kara II* sender. *See, e.g., Kara II*, p. 14, lines 3-9.

Yet further, even assuming (which Applicants do not), for the sake of argument only, that the above-quoted disclosure of *Kara II* could be extended to include a recipient providing a delivery service with address information, it is respectfully asserted that doing so would not comprise a recipient (a first user) providing "... a destination address for the second user to which the particular parcel is to be shipped from the first user ..." as claimed by Claim 12. Rather, according to the cited p. 14, lines 12-33 quotation from *Kara II*, it is respectfully asserted that a *Kara II* user that provided information would be doing so to the delivery service to deliver a document, not "... to which the particular parcel is to be shipped *from the first user* ..." as claimed by Claim 12 (emphasis added).

Citing page 12, lines 18-28 of *Kara II*, the Office Action further posits that *Kara II* discloses calculating a shipping rate. *Office Action*, Topic No. 5.c, p. 4.

However, as further distinguished from the Office Action's characterization that *Kara II* discloses calculating a shipping rate, Claim 12, for example, recites:

> ... calculating a shipping rate to be charged for having the carrier ship the particular parcel from the origin address to the destination address via the delivery service ...

As compared to the above-recited limitation of Claim 12, the above-cited page 12, lines 18-28 of *Kara II* states, in pertinent part:

> ... at a point in the paradigm very near the actual delivery of the document, ... providing for rate discounts such as by batching mail items by ZIP code, etc. ...

Kara II, p. 12, lines 25-27.

It is respectfully asserted that a disclosure in *Kara II* for "...... providing for rate discounts such as by batching mail items by ZIP code, etc. [*at a point in the paradigm very near the actual delivery of the document*] ..." (emphasis added), does not disclose "... calculating a shipping rate to be charged for having the carrier ship the particular parcel *from the origin address to the destination address via the delivery service* ..." (emphasis added), as claimed by Claim 12.

Yet further, it is respectfully submitted that *Kara II* contains no disclosure that the recipient is even a user of the *Kara II* system. Rather, as explained in *Kara II*, "...recipients may provide the delivery service with information ... that is stored by the delivery service ...." *Kara II*, p. 14, lines 13 - 14.

For the above-given reasons, it is respectfully submitted that none of the references of record, whether considered alone or in combination, disclose, anticipate, teach or suggest, for example, the limitations recited by amended Claim 12.

For reasons similar to those given above with respect to Claim 12, it is respectfully asserted that the references of record, whether considered alone or in combination, do not disclose, anticipate, teach or suggest, for example, the following limitations recited by Claim 30:

(A) receiving a set of parcel specifications for a particular parcel to be shipped by a first user to a second user ...
(B) receiving a set of recipient information for a delivery of the particular parcel to the second user ... wherein ...

> said set of parcel specifications is input by the first user via the first user client computer device ...
>
> said set of recipient information is input by the second user via the second user client computer device ...

Claims 27 and 50

With respect to the rejection of Claim 27 under Section 102(e) as being anticipated by *Kara*, in the Office Action, *Kara*'s FIG. 8, reference numeral 803 was cited to support the proposition that "... Kara discloses a shipping management computer system that is programmed to ... [r]eceive a default shipping location associated with the user ...." *Office Action*, Topic No. 8, p. 4. Notably, the element referenced by element number 803 is the *Kara* sender's "Return Address."

The Office Action further asserts that *Kara* discloses, "[f]or each respective carrier ... apply a set of carrier specific rules ... to the default shipping location to determine which ... carriers would support shipping the parcel to the default location ...." *Office Action*, Topic No. 8.g, p. 5.

The rejection of Claim 27 under Section 102(e) as being anticipated by *Kara* has been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and respectfully request reconsideration and allowance of Claim 27.

It is not disputed that in some cases, for some carriers, a user's return address could be the same address as the user's default shipping location for a parcel. However, for the reasons described below, depending on a user's return address, it is respectfully asserted that a user's return address may not necessarily be recognized as a valid shipping location for each carrier. Therefore, for the reasons described below, it is respectfully asserted that a system, such as is claimed by Claim 27, is distinguished from the references of record because, in various embodiments, it would provide for the collection of a default shipping location separate from, and that can be different from, a user's

return address, and would differentiate between carrier-specific support for shipping from a user's default shipping location by "… apply[ing] a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location …."

It is respectfully asserted, for the reasons given and authorities cited below, that the claimed terms "shipping location" and "default shipping location" are distinguished from the various shipping feature considerations and shipping rate calculation factors disclosed by the references of record, including *Kara*. Moreover, it is respectfully asserted, for the reasons given and the authorities cited below, that the limitations of Claim 27 to "…apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location …" are patentably distinguished from the references of record, including *Kara*.

In order to ascertain the meaning of the claimed terms "shipping location," "default shipping location," and "apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location …" as those terms are used in, for example, Claim 27, it is respectfully asserted that it is proper to consider the Specification of the present patent application. *See, e.g., Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), *aff'd*, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history." (citations omitted)).

In the Specification of the present application, FIG. 13 is described as "… a graphic representation of an exemplary embodiment of a Shipping Location screen 43." *Specification*, p. 23, lines 5-6. In describing FIG. 13, the Specification of the present application explains that, "[i]n the Shipping Location screen 43, the System prompts the User to identify a default location 120a from

which the User will typically ship packages and to provide the city, state, and zip code of that location 120b." _Specification_, p. 23, lines 6-9.

It is respectfully asserted that, in view of the above-outlined disclosures of the Specification of the present application, the term "shipping location" recited by Claim 27 is properly interpreted to mean a location from which a User will ship a package. _See, e.g., Specification_, p. 23, lines 5-9.

Further, it is further respectfully asserted that, in view of the above-outlined disclosures of the Specification of the present application, the term "default shipping location" recited by Claim 27 is properly interpreted to mean "...a default location ... from which the User will typically ship packages ...." _Specification_, p. 23, lines 5-9.

The Specification of the present application explains that "[i]n the embodiment depicted, at a minimum, the System requires Source Postal Code, Destination Postal Code, Parcel Weight, Type of Shipment, and the Shipping Location in order to determine a timing schedule and rates for each supported Carrier...." _Specification_, p. 59, lines 14-16.

With respect to an exemplary embodiment, the Specification further explains that:

> There are two types of shipping locations, ship centers and customer drop offs. Ship centers are those locations which refer to a database of specific locations, from which a specific location from the available locations must be selected to determine rates,.... Customer drop offs are those shipping locations from which a specific location need not be selected to determine rates, such as a "drop box", "carrier counter" or "call for pickup". The shipping location pull down menu displays each shipping location category, ... other specific shipping center types, drop box, carrier counter, call for pickup, etc.

Specification, p. 29, lines 16-23.

With reference to FIGS. 39a through 39c, the Specification of the present application then explains, with respect to an exemplary embodiment, that "... if the Shipper has supplied the minimum required specifications, then the System accesses the Shipper Database 1195 to identify any user-specified Carrier

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designations and to determine the Carrier accounts for the appropriate Shipper 1154. Using the Shipper Parcel Specifications, the System then accesses the Carrier Databases (1404a through 1404n) and determines all possible Carrier/Services that support shipping of the subject parcel 1155." *Specification*, p. 59, lines 19-24.

It is respectfully asserted that, in view of the above-outlined disclosures of the Specification of the present application, the phrase "… apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location …" is properly interpreted to mean applying the rules by which a particular Carrier would determine whether or not the particular Carrier would support shipping a particular parcel from a particular user's default shipping location and determining whether, according to the application of the Carriers rules, the Carrier would support shipping the particular parcel from the particular user's default shipping location.

In light of the above-explained meaning of the claimed terms "shipping location," "default shipping location," and "… apply a respective set of carrier-specific shipping location rules …", it is respectfully asserted that a disclosure by a reference of an indication of an identification of delivery services that would support shipping a parcel that does not include consideration of the relevant Carrier's shipping location rules as applied to a particular parcel's specifications and as applied to a particular shipper's default shipping location does not disclose, anticipate, teach or suggest the limitations of Claim 27 to "… apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location …." For the reasons given and the authorities cited below, it is respectfully asserted that *Kara*, even when considered in combination with other references of record, does nothing more than disclose an indication of an identification of delivery services that would support shipping a parcel; they do not disclose, anticipate, teach or suggest consideration of the relevant Carrier's shipping location rules as applied to a

particular parcel's specifications and as applied to a particular shipper's shipping location in the manner claimed by, for example, Claim 27.

It is not disputed that a particular shipping location may have a particular address and may be within a particular zone. Further it is not disputed that *Kara* discloses zone-based shipping rate considerations. *See, e.g., Kara*, col. 21, lines 60-67 (explaining that "... zone information may be utilized in determining the availability of a particular delivery service, such as overnight, certified, or the like, available from particular ones of the shipping service providers."); *Kara*, col. 22, lines 13-16 (disclosing that the "... program will automatically incorporate the ... parameters – weight, class, zone – in order to correctly calculate the correct postage ..."); *Kara*, FIG. 7, element 714 (labeled "Zone – select from box: Local, 1 to 8, Canada, Mexico or International"). It is respectfully asserted that the "Zone" element 714 described in *Kara* is associated with the destination for a mail piece, as reflected in the description of element 714 in FIG. 7 of *Kara* ("... Local, 1 to 8, Canada, Mexico or International ...").

However, for the reasons outlined below, it is respectfully asserted that the limitation "shipping location" recited by Claim 27 is distinguished from a designation of a zone and from a user's address, also sometimes referred to as a user's return address.

The Specification of the present application describes an exemplary embodiment of an input collection screen for collecting a user's address:

> FIG. 12 is a graphic representation depicting an exemplary embodiment of a User address collection screen. As depicted in FIG. 12, the System prompts the User to provide the User's name 106, e-mail address 107, company name 108, street address 109, floor/room number 110, department name 111, city 112, state 113a (using a pull down menu button 113b), telephone number 114, zip code 115, and fax number 116.

Specification, p. 22, lines 18-22. However, in addition to the user's address, the Specification of the present application also describes exemplary embodiments of a "Shipping Location screen" (as depicted in, *e.g.*, FIGS. 13 and 15 of the present application) in which a user can input a default shipping location from which the user will ship parcels. *See, e.g., Specification*, p. 23, lines 5-9.

As compared to zone-based rate calculations as disclosed in _Kara_, it is respectfully asserted that the limitations claimed in one way or another by Claim 27 of determining carriers that would support shipping a particular parcel from a particular shipping location would, under certain circumstances, provide different results than the disclosures of the references of record, and are therefore distinguished from zone-based rate calculations.

In summary, it is not disputed that in some cases, for some carriers, a user's return address could serve as the shipping location for a parcel. However, in view of the above-outlined disclosures of the present application regarding exemplary embodiments, it is respectfully asserted that, depending on a user's return address, a user's return address may not necessarily be recognized as a shipping location for each carrier. Moreover, in view of the above-outlined disclosures of the present application regarding exemplary embodiments, it is ·respectfully asserted that a system, such as is claimed by Claim 27, is distinguished from the references of record because, in various embodiments, it would provide for the collection of a default shipping location separate from a user's return address, and because it would differentiate between carrier-specific support for shipping from the user's default shipping location by "... apply[ing] a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location ...."

With respect to the rejection of Claim 50 under Section 102(e) as being anticipated by _Kara_, in the Office Action, _Kara_'s column 21, lines 60-67 was cited as supporting the proposition that "... Kara discloses a shipping management computer system that is programmed to ... determine a first and second carrier specific origin rating zone identifier ... [and] determine a first and second carrier specific destination rating zone identifier ...." _Office Action_, Topic Number 9, p. 6.

The rejection of Claim 50 under Section 102(e) as being anticipated by _Kara_ has been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and respectfully request

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reconsideration and allowance of Claim 50.

It is respectfully submitted that, as compared to disclosing "... a shipping management computer system that is programmed to ... determine a first and second carrier specific origin rating zone identifier ... [and] determine a first and second carrier specific destination rating zone identifier ..." as stated in the Office Action, *Kara*'s column 21, lines 60-67 states that "... the *user* may select a particular zone associated with the mail piece of other item ... ." (Emphasis added). It is respectfully submitted that a *user selecting* a particular zone associated with a mail piece as disclosed in the cited excerpt of *Kara* is distinguished from *a system determining a rating zone identifier* as recited in Claim 50 as follows:

> (a) determining a first carrier-specific origin rating zone identifier that a first carrier would associate with the origin postal code;
> (b) determining a second carrier-specific origin rating zone identifier that a second carrier would associate with the origin postal code;
> (c) determining a first carrier-specific destination rating zone identifier that said first carrier would associate with the destination postal code;
> (d) determining a second carrier-specific destination rating zone identifier that said second carrier would associate with the destination postal code;

Further, with respect to the rejection of Claim 50 under Section 102(e) as being anticipated by *Kara*, in the Office Action, *Kara*'s FIG. 8 was cited to support the proposition that "... Kara discloses a shipping management computer system that is programmed to ... [c]alculate[,] using zone identifiers, rates of first and second delivery services of the first and second carriers ...." *Office Action*, Topic Nos. 9 and 9.k.iv, p. 6.

However, as compared to disclosing "... [c]alculat[ing,] using zone identifiers, rates of first and second delivery services of the first and second carriers ...." as stated by the Office Action, it is respectfully submitted that *Kara* discloses a comparison of rates across multiple carriers, but requires a user's pre-selection of a delivery service "urgency" and/or class, and therefore

does not disclose calculating rates for more than one delivery service for a particular carrier. *See, e.g.,* *Kara*, col. 22, lines 39 – 42 ("the ... program automatically calculates the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters.*" (emphasis added). That is, according to *Kara*, a user of *Kara* must first indicate the desired shipping and/or delivery parameters (*e.g.,* Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day) so that the *Kara* "program [will] automatically calculate[ ] the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters.*" *Kara,* col. 22, lines 39 – 42 (emphasis added).

As distinguished from a user pre-selecting a delivery service as disclosed in *Kara*, Claim 50 recites, in response to receiving a request to ship a particular parcel, among other things:

> (e) calculating a first service-specific, carrier-specific shipping rate for a first delivery service offered by said first carrier according to at least the first carrier-specific origin rating zone, the first carrier-specific destination rating zone, and the set of parcel specifications;
>
> (f) calculating a second service-specific, carrier-specific shipping rate for a second delivery service offered by said first carrier according to at least the first carrier-specific origin rating zone, the first carrier-specific destination rating zone, and the set of parcel specifications;
>
> (g) calculating a third service-specific, carrier-specific shipping rate for a first delivery service offered by said second carrier according to at least the second carrier-specific origin rating zone, the second carrier-specific destination rating zone, and the set of parcel specifications; and
>
> (h) calculating a fourth service-specific, carrier-specific shipping rate for a second delivery service offered by said second carrier according to at least the second carrier-specific origin rating zone, the second carrier-specific destination rating zone, and the set of parcel specifications.

That is, even assuming for the sake of argument that *Kara* could be used to execute each of the above-outlined processes, it is respectfully asserted that there is no disclosure in *Kara*, that *Kara* could do so in response to the singular receipt a request to ship a particular parcel. Rather, it is respectfully asserted

that according to the disclosure of _Kara_, even assuming for the sake of argument that _Kara_ could be used to execute each of the above-outlined processes, _Kara_ could only be used to do so in multiple stages -- each stage requiring a user to first pre-selected a delivery service "urgency" and/or class. _See, e.g._, _Kara_, col. 22, lines 39 – 42

Further, it is respectfully asserted that although the references of record mention consideration of zone information, there is no mention in any of the references of record of any distinction between Carriers and/or Services as to differences in support, and/or rates, for different shipping locations, including different shipping locations that may exist within a single zone.

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of _Kara_ on the one hand, and Claims 27 and 50, on the other hand, it is respectfully asserted that Claims 27 and 50 are patentable over the references of record.

Claims 44 and 45

In rejecting Claim 44 under Section 102(e) as being anticipated by _Nicholls_, the Office Action cites the "Rate button" and the "Repeat button" of FIG. 4B of _Nicholls_ to support the proposition that "... Nicholls discloses a shipping management computer system that is programmed to ...generat[e] an interactive user display ... comprising ... an executable set of instructions for regenerating the interactive user interface display in response to a user modification of data ...." _Office Action_, Topic No. 11, pgs. 6-7.

The rejections of Claims 44 and 45 under Section 102(e) as being anticipated by _Nicholls_ have been carefully considered. Applicant(s) respectfully disagree with the rejections for the following reasons and respectfully request reconsideration and allowance of Claims 44 and 45.

As compared to the above-quoted assertions of the Office Action, Claim 44, for example, recites:

> generating a displayable interactive user interface adapted for displaying the rating and scheduling information, wherein the displayable interactive user interface comprises:

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(A) at least one data collection field initialized with a data item from the set of data input by the particular user;

(B) the set of rating and scheduling information; and

(C) an executable set of instructions for regenerating the interactive user interface display in response to a user modification of data in the at least one data collection field.

It is not disputed that FIG. 4B of _Nicholls_ displays a "Rate" button and a "Repeat" button. It is disputed, however, that the display of a "Rate" button and/or a "Repeat" button on an online display discloses the above-recited limitations of, for example, Claim 44 for "... generating a displayable interactive user interface ... [that] comprises ... an executable set of instructions for regenerating the interactive user interface display _in response to a user modification of data in the at least one data collection field_." (Emphasis added).

More specifically, as compared to the mere display in FIG. 4B of _Nicholls'_ of a "Rate" button and/or a "Repeat" button, the claimed limitation recites "...regenerating the interactive user interface display _in response to a user modification of data in the at least one data collection field_." It is respectfully submitted that the explanation provided by the Specification of the present application, with respect to various non-limiting exemplary embodiments, is instructive. In particular, the Specification of the present application explains, with respect to various non-limiting exemplary embodiments, that:

> Distribution to the Web Browser Client by the System of executable code that regenerates the Graphic Array provides the capability to dynamically reflect in the Graphic Array any changes that the Shipper may enter to the various Shipper Parcel Specifications; the Graphic Array immediately displays the new information _without requiring the Shipper to request a recalculation, such as by clicking on a "Regenerate" button or the like_.

Specification, p. 64, lines 3 – 7 (emphasis added).

The Specification of the present application further describes that for various exemplary embodiments:

> ... the System automatically and dynamically regenerates the display of the Graphic Array and certain portions of other screens when the Shipper makes online changes to Shipper input. To do this, the System generates executable code which it distributes with certain displayable frames to the Web Browser Client. This distribution of code for purposes of regenerating the Graphic Array differs from the initial generation of the

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Graphic Array as was described above. For example, in the embodiment of the invention depicted in FIGS. 39a through 39c, in the initial development of the Graphic Array, the System distributes the functions that initially generate the Graphic Array as follows: the Shipper entering shipping information 1150, displaying errors to the Shipper that insufficient shipping information has been provided and prompting the Shipper for additional information 1153, and displaying the Graphic Array 1160, are all processed by the Web Browser at the Client; all other functions and processes depicted in FIGS. 39a through 39c are performed by one or more of the NOC Servers 20a-21z.

Specification, p. 63, line 18 – p. 64, line 2.

As the System generates the display of each frame, the System generates executable code which it distributes with, e.g., the Rate & Times frame, to the Web Browser Client. Thereafter, the Web Browser Client uses the executable code to automatically regenerate the display of the Graphic Array each time the Shipper makes changes to the Shipper Parcel Specifications. In one embodiment of the dynamic regeneration aspect of the invention, the executable code distributed to the Web Browser Client uses JavaScript.

Specification, p. 64, lines 18 – 23.

The Office Action's citation to the "Rate" button and the "Repeat" button of FIG. 4B of _Nicholls_ is evidence that _Nicholls_ does not disclose the limitation recited, for example, by Claim 44 of "…an executable set of instructions for regenerating the interactive user interface display in response to a user modification of data in the at least one data collection field." In particular, the Office Action's citation to the "Rate" button and the "Repeat" button of FIG. 4B of _Nicholls_ indicates that a _Nicholls_ user would need to click the "Rate" button, or the "Repeat" button of FIG. 4B of _Nicholls_ in order to cause the _Nicholls_ system to regenerate the screen depicted in FIG. 4B of _Nicholls_.

As compared to a user needing to click a separate "Rate," "Update," "Repeat" or other-named button in order to regenerate an updated version of a screen, Claim 44 recites "…an executable set of instructions for regenerating the interactive user interface display _in response to a user modification of data in the at least one data collection field._" (Emphasis added.)

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For the reasons given above, it is respectfully submitted that neither _Nicholls_ nor any of the other cited references disclose, anticipate, teach or suggest the above-recited limitations of Claim 44, or the limitations of Claim 45 which is dependent on independent Claim 44. Accordingly, it is respectfully asserted that Claims 44 and 45 are patentable over the references of record.

Claims 31 and 49

In rejecting Claim 31, the Office Action cites element reference numeral 34 (in FIG. 1) and FIG. 4I of _Nicholls_ as supporting the proposition that "... Nicholls discloses a shipping management computer system, which is programmed to ... [i]nstruct the client computer device to recognize a measured weight of a parcel using a digital scale ...." _Office Action_, Topic No. 16, p. 8.

The rejection of Claim 31 under Section 103(a) as being unpatentable over _Nicholls_ in view of _Kara_, has been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and respectfully request reconsideration and allowance of Claim 31.

Claim 31 is directed to "A server-based shipping management computer system comprising at least one computer device, wherein said server-based shipping management computer system is programmed to...", among other things:

> (A) communicate with a plurality of client computer devices via a global communications network;
> (B) for each of said plurality of client computer devices:
> (1) send executable program instructions to the client computer device to:
> > (a) instruct the client computer device to recognize a measured weight of a particular parcel, said weight being measured by a digital scale configured with the client computer device, and
> > (b) instruct the client computer device to communicate the measured weight to the shipping management computer system via the global communications network ...

It is respectfully submitted that, notwithstanding the disclosure of a scale in both _Nicholls_ (element 34 of FIG. 1) and _Kara_ (element 103, FIG. 1A), as

compared to the above-recited limitations of Claim 31, there is no disclosure in either *Nicholls* or *Kara* of, and the Office Action does not cite any evidence that either *Nicholls* or *Kara* disclose, "...send[ing] executable program instructions to the client computer device ..." as recited by Claim 31 or for the such executable program instructions being "...to ... instruct the client computer device to recognize a measure weight ... being measured by a digital scale configured with the client computer device ..." as recited by Claim 31.

The Office Action states that, with respect to Claim 31, "[t]he applicant is arguing that there is no disclosure in Nicholls to send executable program instructions to instruct the client computer device to recognize a measured weight. The computer system of Nicholls send a user interface to a client device. In the user interface the weight is entered, therefore by sending the user the user interface, it therefore sends instructions to recognize the weight, therefore causing weight to be used in the calculation...." *Office Action*, Topic No. 37, p. 16. The Office Action continues with the assertion that "[t]he client computer device is not going to automatically populate the weight field, unless there is some instruction as to how to populate it. The user interface is associated with the computer system; therefore inherently by displaying the user interface will send instructions for the user device to recognize a measured weight, as long as in the program there it allows for a scale. Therefore it is the examiner's position that Nicholls teaches every limitation of Claims 31 and 49 ...." *Office Action*, Topic No. 37, pgs. 16-17.

For the reasons given and the authorities cited herein, it is respectfully asserted that the above-quoted assertions by the Office Action are based on impermissible hindsight using the invention claimed in the present application as a roadmap to pick and choose disparate portions of the *Nicholls* reference and using what could be described as "common sense" arguments based on the disclosure and teachings of the present application, not based on any evidence in the prior art, to combine those portions to conclude anticipation of Claims 31 and 49. *Cf., e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37

U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; "...
decomposing an invention into its constituent elements, finding each element in
the prior art, and then claiming that it is easy to reassemble these elements into
the invention, is a forbidden *ex post* analysis. ... With hindsight the transistor is
obvious; but devising the transistor was still a work of genius. An invention lies in
a combination of elements that are themselves mundane. 'Virtually all inventions
are combinations and virtually all are combinations of old elements.'.... Unless
the prior art *itself* suggests the particular combination, it does not show that the
actual invention was obvious or anticipated.") (Citations omitted); *cf. also, e.g., In
re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001)
("With respect to core factual findings in a determination of patentability,
however, the Board cannot simply reach conclusions based on its own
understanding or experience – or on its assessment of what would be basic
knowledge or common sense. Rather, the Board must point to some concrete
evidence in the record in support of these findings.").

In rejecting Claim 49, the Office Action repeats many of the above-quoted
assertions regarding the rejection of Claim 31 with respect to instructing a client
computer to recognize a measured weight, instructing the client computer to
communicate the measured weight, and the like. *See, e.g., Office Action*, Topic
No. 23, p. 11.

In rejecting Claim 49, the Office Action states that "Nicholls and Kara,
disclose the use of calculating and displaying rates for specific services, for
multiple carriers, but fails to disclose the simultaneous display of rates for each
carrier that includes rates of different services ...." *Office Action*, Topic No. 25, p.
12.

In order to compensate for the above-quoted statement of failure by the
Office Action of *Nicholls* and *Kara*, the Office Action then asserts that: "Thiel
discloses the use of a system for calculating rates for multiple carriers for multiple
services (see abstract), and discloses the computer storing data for the rates of
each service for each carrier in one table (Column 11, lines 1-13)." *Office Action*,
Topic No. 25, p. 12. The Office Action further asserts that "Thiel also discloses

that the system will walk the user through which service is wanted, however discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54)." *Office Action*, Topic No. 25, p. 12.

The Office Action then states that "Nicholls, Kara and Thiel fail to disclose the "simultaneous" display of shipping charges for each service of each carrier." In a final effort to compensate for the above-quoted statement of failure by the Office Action of *Nicholls*, *Kara* and *Thiel*, the Office Action then asserts that "[i]t would have been obvious to one having ordinary skill in the art ... to display all charges simultaneously." *Office Action*, Topic No. 26, p. 12. In an effort to support the asserted obviousness, the Office Action posits that "Thiel even shows all the rates are stored in one table, however, they all require some sort of selection by the user before each charge is displayed." *Office Action*, Topic No. 26, p. 12.

The rejection of Claim 49 concludes with the reasoning that "[t]he way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes. It should also be noted that the claims are all drawn to system claims, which are limited to the actual systems and their capabilities, and that what information is actually displayed is considered to be printed matter, and unless the information is used further in the system, then what is actually displayed is considered non-functional." *Office Action*, Topic No. 26, pgs. 12-13.

The rejection of Claim 49 under Section 103(a) as being unpatentable over *Nicholls* in view of *Kara* and *Thiel*, has been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and respectfully request reconsideration and allowance of Claim 49.

First, as compared to the aforementioned assertions in the Office Action regarding Claim 49, it is respectfully asserted that Claim 49 does not recite the limitations regarding weight asserted in the Office Action.

Further, the final reasoning of the rejection outlined above is taken to be a printed matter rejection. However, for the reasons given and the authorities cited

below, it is respectfully asserted that a printed matter rejection is misplaced.

Yet further, with regard to the aforementioned "printed matter" rejection, as the Office Action admits, it is respectfully noted that the rejected claims are directed to computer systems. It is respectfully submitted that computer systems have been well established as being patentable subject matter under 101.

Further still, "... when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, (United States Patent and Trademark Office; *Official Gazette* Notices for November 22, 2005), § II.C (*citing Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under Sec. 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.")).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. Gulack, 703 F.2d at 1385. The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981)." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, __ (Fed. Cir. 1994). Further, the *In re Lowrey* court noted "... that Gulack cautioned against a liberal use of 'printed matter rejections' under section 103 ... A 'printed matter rejection' under [[section]] 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The

Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." *In re Lowry*, 32 F.3d at 1583 (quoting *Gulack*, 703 F.2d at 1385 n.8).

It is respectfully asserted, for the reasons given below, that the above-quoted citation to the table of *Thiel* cited (at *Thiel*, col. 11, lines 1-13 (the "*Thiel Table*")) by the Office Action does not support the assertion by the Office Action that "Thiel discloses ... the computer storing data for the rates of each service for each carrier ...." *Office Action*, Topic 25, p. 12.

In comparing the cited *Thiel Table* to both the features attributed to it in the Office Action, and more importantly, to the claimed limitations of for example, Claim 49, it is respectfully asserted that the contents of the cited *Thiel Table* and the description by *Thiel* of the use of the cited *Thiel Table* as described by *Thiel* are instructive.

At first glance, the cited *Thiel Table* may appear to provide a stored shipping rate comparison. However, it is respectfully submitted that under close inspection, the cited *Thiel Table* provides a stored comparison of base rate components, not of shipping rates that have been calculated by the claimed system (as claimed for example, by Claim 49).

Specifically, Claim 49 recites, among other things, the following limitations:

> (4) using said first carrier-specific ratable weight to determine whether a first carrier would support shipping the particular parcel, and, if the first carrier would support shipping the particular parcel, calculating a first service-specific, carrier-specific shipping rate for a first delivery service offered by the first carrier and calculating a second service-specific, carrier-specific shipping rate for a second delivery service offered by the first carrier;
> (5) using said second carrier-specific ratable weight to determine whether a second carrier would support shipping the particular parcel, and, if the second carrier would support shipping the particular parcel, calculating a third service-specific, carrier-specific shipping rate for a first delivery service offered by the second carrier and calculating a fourth service-specific, carrier-specific shipping rate for a second delivery service offered by the second carrier;
> (6) displaying to a display device in communication with the remote client computer device, a simultaneous cross-comparison of

the first, second, third and fourth service-specific, carrier specific shipping rates.

As compared to storing calculated shipping rates, the cited *Thiel Table* is shown as containing shipping feature entries for five (5) different carriers. *See Thiel*, col. 11, lines 1-13. For each of the five (5) different carriers (Carrier 1-5), the cited *Thiel Table* shows a shipping feature entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. *Id.* at col. 11, lines 1-13.

As compared to *calculating rates* for multiple carriers for multiple services for a *simultaneous display* of rates for multiple services for multiple carriers (as is claimed by, for example, Claim 49, it is respectfully submitted that *Thiel* describes the cited *Thiel Table* as a *stored* table of services and fee *components* of various carriers. Further, *Thiel* explains that the cited stored *Thiel Table* is used by the *Thiel* system to "... search[] the carriers which offer the desired services ..." (*Thiel*, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (*Thiel*, col. 11, lines 29-30). That is, the cited *Thiel Table* is used by the *Thiel* system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited *Thiel Table* does not contain calculated shipping rates for shipping a parcel.

Yet further, Applicant(s) disagree, with regard to the effort in the Office Action to compensate for the above-quoted conclusion that "Thiel ... discloses displaying only the final rate for desired service for multiple carriers ...," with the assertion in the Office Action that even though "Nicholls, Kara and Theil [sic] fail to disclose the "simultaneous" display of shipping charges for each service of each carrier ...[, i]t would have been obvious ... to display all charges simultaneously."

Applicants respectfully disagree that the above-quoted assertion of obviousness is properly supported by sufficient evidence as required for an

obviousness rejection under MPEP §706.02(j) and MPEP §2143. Rather, it is respectfully asserted that the Office Action's concession that a simultaneous display as claimed by the rejected Claims is completely absent from the references cited is strong evidence that such a simultaneous display is not obvious. *Cf., e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). "Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated." *Id.*

Even after making the above-stated concessions of the complete absence of a simultaneous display as claimed in one way or another by Claims 1-6, 28-33. 49-52 and 58, in an effort to justify the rejection under Section 103(a), the Office Action nevertheless posits that "the way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes." *Office Action*, Topic No. 26, Page 12.

It is respectfully asserted that picking and choosing disparate portions of the cited references, asserting characterizations of those references that are not supported by the references themselves, and then, even acknowledging the complete absence in the asserted combination of the references of the claimed limitations, asserting that the claimed limitations would be obvious, is proscribed. In particular, it is respectfully submitted that "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

In view of the above-given reasons and the authorities cited above, it is respectfully asserted that the above-recited limitations of Claim 49 are distinguished from and patentable over the cited references. Accordingly, reconsideration and allowance of Claim 49 is respectfully requested.

Claims 29, 33-35 and 42

For reasons similar to those described above with respect to Claim 49, it is respectfully submitted that all of Claims 29, 33-35 and 42 are distinguished from the cited references because all of Claims 29, 33-35 and 42 are directed, in one way or another to calculating or displaying shipping rates, or determining delivery schedules, as the case may be, for more than a single delivery service for a single carrier.

Claim 36

In rejecting Claim 36, the Office Action mentions a reference identified in the Office Action only as "Fisher." In a previous Office Action, a reference named "Fisher" was identified as U.S. Patent No. 6,047,264 ("*Fisher*"). The reference in the present Office Action to "Fisher" is taken to refer, therefore, to U.S. Patent No. 6,047,264.

The rejection of Claim 36 under Section 103(a) as being unpatentable over *Nicholls* in view of *Fisher* and *Kara* has been carefully considered. For the reasons given, and the authorities cited, below, Applicant(s) respectfully disagree with the rejection and request reconsideration and allowance of Claim 36.

First, for reasons similar to those described above with respect to amended Claim 49, it is respectfully submitted that Claim 36 is distinguished from the cited references because amended Claim 36 is directed to determining, for each carrier-specific delivery service offered by each carrier, whether the respective carrier-specific delivery service would provide shipping notification for delivering a parcel.

In rejecting Claim 36, the Office Action states that "Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A) ...." *Office Action*, Topic No. 28, p. 13.

Applicant(s) respectfully disagree that the statement in the Office Action that "Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A) ...." (*Office Action*, Topic No. 28, p. 13) fully reflects the limitations of Claim 36.

For example, Claim 36 recites the limitations that "...*for each carrier-specific delivery service offered by each respective carrier of a plurality of carriers*, determine whether the respective carrier-specific delivery service would provide delivery notification for delivering the particular parcel ...." (Emphasis added). Claim 36 further recites the limitations for "...displaying to a display device configured with the client computer device, *an identification of each carrier-specific delivery service* of each respective carrier of the plurality of carriers that would provide the delivery notification service." (Emphasis added).

Therefore, because the foundation posited in the Office Action for rejecting Claim 36 does not fully reflect the limitations of Claim 36, Applicant(s) respectfully disagree that the Office Action presents a proper foundation for combining *Fisher* with *Nicholls* as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

As compared to the above-recited limitations of Claim 36, it is respectfully submitted that none of the cited references, including *Nicholls*, disclose any variation in carrier-support of Proof of Delivery. That is, it is respectfully submitted that none of the cited references, including *Nicholls*, disclose that some carriers may provide Proof of Delivery and that some carriers may not. Rather, it is respectfully asserted that it appears that the cited references, including *Nicholls*, assume that all carriers provide Proof of Delivery. It is respectfully asserted that it appears that if a user, in addition to entering other shipping information, designated the "Proof of Delivery" option in the *Nicholls* FIG. 4A, the *Nicholls* system would calculate a rate that would include any charge by a carrier for the requested "Proof of Delivery" option. However, it is respectfully submitted that there is no disclosure in *Nicholls*, that the *Nicholls* system would test whether a carrier would, or would not, provide the "Proof of Delivery" option.

As compared to the apparent assumption by *Nicholls* that all carriers provide the "Proof of Delivery" service, it is respectfully asserted that, for example, Claim 36 recites limitations that reflect the ability to differentiate between different carrier-specific support for delivery notification. For example,

Claim 36 recites the limitations "...*for each carrier-specific delivery service offered by each respective carrier of a plurality of carriers*, determine whether the respective carrier-specific delivery service would provide delivery notification for delivering the particular parcel ...." (Emphasis added).

The Office Action further states that "Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to disclose the specific delivery requirements includes an electronic mail delivery notification." *Office Action*, Topic No. 28, p. 13. In order to compensate for the above-quoted statement that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...," the Office Action states that "Fisher discloses a method for supplying automatic status updates using e-mail (see abstract) ..." and asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as displayed by Fisher ...." *Office Action*, Topic No. 28, p. 13. The Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative [citing *Fisher*, cols. 1 and 2]." *Office Action*, Topic No. 28, p. 13.

As opposed to the above-quoted assertions of the Office Action regarding *Nicholls* and *Fisher* repeated mention of a carrier's "specific delivery requirements," it is respectfully submitted that Claim 36 does not recite any limitation regarding a carrier's "delivery requirements." Rather, Claim 36 recites, for example, "... (B) for each of said user client computer devices: (1) receiving, from the user client computer device, a request to ship a particular parcel, said request including a request that a delivery notification service be implemented in association with the shipment of the particular parcel; ...."

Further, as opposed to the above-quoted statement in the Office Action that "Fisher discloses a method for supplying automatic status updates using e-mail ...," (*Office Action*, Topic No. 28, p. 13), it is respectfully submitted that the

limitations claimed by Claim 36 are not directed to supplying, or in any way providing, automatic status updates using email. Rather, Claim 36 recites limitations, for example, to "...(B) for each of said user client computer devices: (1) receiving, from the user client computer device, a request to ship a particular parcel, said request including a request that a delivery notification service be implemented in association with the shipment of the particular parcel ..." and then, "...(2) in response to said request:..."

> (a) for each carrier-specific delivery service offered by each respective carrier of a plurality of carriers, determine whether the respective carrier-specific delivery service would provide delivery notification for delivering the particular parcel, and
> (b) displaying to a display device configured with the client computer device, an identification of each carrier-specific delivery service of each respective carrier of the plurality of carriers that would provide the delivery notification service.

For the foregoing reasons and authorities, it is respectfully asserted that the combination of *Fisher* with *Nicholls* asserted in the Office Action is based on an improper foundation that fails to accurately reflect the claimed limitations of Claim 36. Accordingly, it is respectfully asserted that there is an insufficient foundation for rejection of Claim 36 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

Yet further, for the following reasons and authorities, it is respectfully asserted that the Office Action offers no evidence to support the asserted combination of *Nicholls* and *Fisher*. It is therefore respectfully asserted that the Office Action provides insufficient evidence of the asserted obviousness to make the asserted combination of *Nicholls* and *Fisher*.

The Office Action states that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...," but posits that "Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ...," and then follows with the conclusion that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as displayed by Fisher ...." *Office Action*, Topic No. 28, p.

13. Citing *Fisher* itself, the Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative [citing *Fisher*, cols. 1 and 2]." *Office Action*, Topic No. 28, p. 13.

For the following reasons and authorities, it is respectfully asserted that the Office Action's citation to *Fisher* alone provides insufficient basis to combine a feature of *Fisher* posited by the Office Action with *Nicholls*.

First, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over e-mail ...," it is respectfully submitted that Claim 16 is not directed to supplying, or in any way providing, delivery notification, such as automatic status updates using email.

Yet further, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over e-mail ...," it is respectfully submitted that *Nicholls* does not disclose "... automatically send[ing] delivery status messages over email ...."

Further still, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over e-mail ...," it is respectfully submitted that there is no disclosure in *Fisher* of the *Fisher carriers* themselves providing any type of delivery notification. Rather, in *Fisher*, as further explained below, the *Fisher system* interrogates a carrier's system to determine the status of a customer's respective shipment; the *Fisher system* then composes an email message to the respective customer regarding the status of the customer's respective shipment.

Yet further, it is respectfully asserted that, as distinguished from the *Fisher* system composition of an email message to a customer, Claim 36 does not recite composing any type of delivery notification

It is respectfully submitted that "... decomposing an invention into its

constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). " Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated." *Id.*

In view of the holding of In re *Mahurkar*, in view of the actual limitations recited by Claims 1-6, 49-52 and 58, in view of the absence of any teaching or suggestion in *Nicholls* to "... automatically send delivery status messages over e-mail ...," and in view of the absence of any disclosure in *Fisher* of email or other delivery notification by carriers themselves, it is respectfully asserted, therefore, that neither *Fisher* nor *Nicholls* suggests the combination, and that the reasoning asserted by the Office Action for combining the two references is therefore unsupported.

Yet further, for the following reasons and authorities, it is respectfully asserted that even when combined, the combination of *Nicholls* and *Fisher* provide an insufficient foundation for rejection of Claim 36 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

In order to compensate for the above-quoted statement that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...," (*Office Action*, Topic No. 28, p. 13), the Office Action states that "Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ..." and asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as displayed by Fisher ...." *Office Action*, Topic No. 28, p. 13. The Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2]." *Office*

Action, Topic No. 28, p. 13.

As previously mentioned above, it is respectfully submitted that there is no disclosure in *Fisher* of the *Fisher carriers* themselves providing any type of delivery notification. Rather, in *Fisher*, as further explained below, it is the *Fisher system* that interrogates a carrier's system to determine the status of a customer's respective shipment; it is the *Fisher system* that then composes an email messages to the respective customer regarding the status of the customer's respective shipment.

Fisher discloses a merchant system that tracks shipment status of a customer's order sent by a particular merchant using a particular carrier to the respective ordering customer. According to *Fisher*, the *Fisher* system interrogates the carrier's system to determine the shipping status of the respective order. The *Fisher* system then composes and sends an email notice to the respective ordering customer regarding their respective order shipment status. *Fisher*, col. 2, lines 12 – 18.

As compared to a system such as disclosed in *Fisher* that itself composes a shipment status email message based on a carrier-system interrogation, it is respectfully asserted that Claim 36 recites, for example, limitations that "... displaying to a display device configured with the client computer device, an identification of *each carrier-specific delivery service of each respective carrier of the plurality of carriers that would provide the delivery notification service...*" (emphasis added). That is, as compared to the *Fisher* system that itself provides shipment status, Claim 36 is directed to providing a simultaneous identification of various carriers and various delivery services that would provide delivery notification for shipping a parcel.

It is respectfully asserted, for the reasons described and authorities cited above, that none of *Nicholls*, *Kara*, or *Fisher*, whether considered alone or in combination with any other reference of record, anticipate, disclose, teach or suggest all of the limitations of the Claim 36 of the present application. Accordingly, it is respectfully asserted that Claim 36 is non-obvious in view of, and patentable over, the references of record.
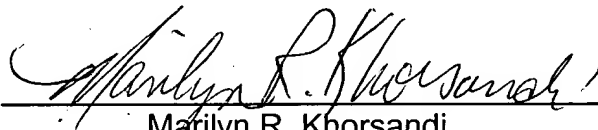
CONCLUSION

For all the foregoing reasons and authorities, it is respectfully asserted that none of cited references, or any of the other references of record, whether considered alone or in combination with each other, disclose, teach or suggest all of the limitations of the Claims, as amended, of the present application.

Therefore, in view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully asserts that the invention disclosed and claimed in the present application as amended is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the application.

Respectfully submitted,

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